

All communications respecting this case should identify it by number and names of parties.



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**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Applicants: Goicoechea et al.

Serial No.: 08/461,402

Filed: 06/05/95

Title: BIFURCATED ENDOLUMINAL
PROSTHESIS

Accorded Benefit of: European
Applications EP9440284.9 filed
02/09/94 and EP94401306.9 filed
06/10/94; and U.S. Serial No.
08/317,763 filed 10/04/94, now
Patent No. 5,609,627 issued
03/11/97

The case referred to above has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with other cases hereafter specified. Attention is directed to the fact that this interference is declared pursuant to 37 CFR 1.601 et seq., effective February 11, 1985 (49 F.R. 48416. 1050 O.G. 385). The interference is designated as No. 104,083.

By direction of the Commissioner of Patents and Trademarks and as required by 35 USC 135(c), notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference."

Attachment
(37 CFR § 1.611(c))

The cases involved in this interference are:

JUNIOR PARTY

Patentee: Eric C. Martin
134 Old Post Road North
Croton on Hudson, NY 10520

Patent: 5,575,817 issued 11/19/96, Serial No.
08/293,541 filed 08/19/94

Title: AORTO FEMORAL BIFURCATION GRAFT AND METHOD OF
IMPLANTATION

Assignees: None

Attorney(s): Robert J. Koch

Associate Attorney(s): None

Accorded Benefit of: None

Correspondence Address: Robert J. Koch
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Washington, D.C. 20004

SENIOR PARTY

Applicants: George Goicoechea
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Freeport, Grand Bahama, Bahamas

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Claude Mialhe
Av. Pierre Brossolette
83300 Draguignan, France

Andrew H. Cragg
4502 Edina Boulevard
Edina, Minnesota 55424

Michael D. Dake
665 Gerona Road
Standford, CA 94305

Application: 08/461,402 filed 06/05/95

Title: BIFURCATED ENDOLUMINAL PROSTHESIS

Assignees: Boston Scientific Technology, Inc.,
A Minnesota Corporation

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Anthony L. Dibartolomeo, Allan M. Wheatcraft,
Anthony Grillo and Leon Nigohosian, Jr.

Associate Attorney(s): None

Accorded Benefit of: European Applications EP9440284.9 filed
02/09/94 and EP94401306.9 filed
06/10/94; and U.S. Serial No. 08/317,763
filed 10/04/94, now Patent No. 5,609,627
issued 03/11/97

Correspondence Address: Paul F. Prestia
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Valley Forge, PA 19482

Count 1

An apparatus for reinforcing a bifurcated lumen
comprising:

a first section, configured to be positioned within the
lumen, comprising:

an upper limb, configured to fit within the lumen upstream of the bifurcation;

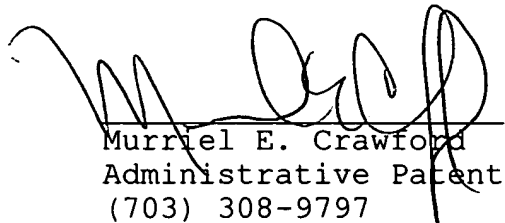
a first lower limb, configured to extend into a first leg of said bifurcation when said first section is positioned in the lumen, and

a second lower limb, shorter than said first lower limb, and configured so that when said first section is positioned in the lumen, said second lower limb does not extend into a second leg of said bifurcation.

The claims of the parties which correspond to this count are:

Martin : Claim 1

Goicoechea et al.: Claim 89



Murriel E. Crawford
Administrative Patent Judge
(703) 308-9797

gjh

INTERFERENCE INITIAL MEMORANDUM

BOARD OF PATENT APPEALS AND INTERFERENCES: An interference is found to exist between the following cases:
This interference involves 3 parties

Count # 1104083(A)

PARTY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
MARTIN	CB/293,241	8/19/94	5,575,811	11/19/96
If application has been patented, have maintenance fees been paid? <u>Yes</u> <u>No</u> <u>X</u> Maintenance fees not due yet				
Accorded the benefit of COUNTRY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
The claim(s) of this party which correspond(s) to this count is(are): PATENTABLE CLAIMS <u>①</u> UNPATENTABLE CLAIMS				
The claim(s) of this party which does/do not correspond to this count is(are): PATENTABLE CLAIMS <u>2-7</u> UNPATENTABLE CLAIMS				
PARTY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
CRAGG	963,787	2/05/95		
If application has been patented, have maintenance fees been paid? <u>Yes</u> <u>No</u> <u>X</u> Maintenance fees not due yet				
Accorded the benefit of COUNTRY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
EPO	EP94400284.9	2/09/94		
EPO	EP9440306.9	6/10/94		
US	08/312,881	9/27/94		
US	08/317,763	10/04/94	5,609,627	03/11/97
The claim(s) of this party which correspond(s) to this count is(are): PATENTABLE CLAIMS <u>54,59,63,64,67</u> UNPATENTABLE CLAIMS				
The claim(s) of this party which does/do not correspond to this count is(are): PATENTABLE CLAIMS <u>62,68</u> UNPATENTABLE CLAIMS				

Instructions

- For every patent involved in the interference, check if the fees have been paid by contacting the MAINTENANCE FEE DEPARTMENT at 308-5069. If fees are due and they have not been paid, the interference cannot be declared since it would involve an expired patent (35 USC 135(a); 37 CFR 1.606).
 - For each party, separately identify the patentable and unpatentable claims which correspond to the count (37 CFR 1.601 (f), 1.601 (n), 1.609(b)(2)).
 - For each party, separately identify the patentable and unpatentable claims which do not correspond to the count (37 CFR 1.609(b)(3)).
 - Forward all files including those the benefit of which is being accorded.
 - Keep a copy of the Interference Initial Memorandum and any attachments for your records.
- All information requested below must be attached on (a) separate sheet(s) and type-written.
- On a separate sheet, set forth a single proposed interference count. If any claim of any party is exactly the same word for word as this count, please indicate the party, application or patent number, and the claim number.
 - For each claim designated as corresponding to the count, provide an explanation of why each claim defines the same patentable invention (37 CFR 1.609(b)(2)).
 - For each claim designated as not corresponding to the count, provide an explanation of why each claim defines a separate patentable invention (37 CFR 1.609(b)(3)).
 - For each additional count, if any, repeat steps 2-6 and, additionally, provide an explanation why each count represents a separate patentable invention from every other count (37 CFR 1.609(b)(1)).

DATE <u>12/12/97</u>	PRIMARY EXAMINER (Signature) <u>Michael J. Milano</u>	TELEPHONE NO. <u>703-308-2496</u>	ART UNIT <u>3308</u>
DATE	GROUP DIRECTOR SIGNATURE (if required)		

The serial number and filing date of each application the benefit of which is intended to be accorded must be listed. It is not sufficient to merely list the earliest application if there are intervening applications necessary for continuity.

THIS PAGE CAN BE DUPLICATED IF THERE ARE MORE THAN TWO INTERFERING PARTIES.

INTERFERENCE INITIAL MEMORANDUM

BOARD OF PATENT APPEALS AND INTERFERENCES: An interference is found to exist between the following cases:

This interference involves 3 partiesCount # 1
104083

PARTY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
CRAGG	EP 94400284.9	02/09/94		
EPO	EP 94401306.9	06/10/94		
US	08/317,763	10/04/94		

If application has been patented, have maintenance fees been paid? Yes No Maintenance fees not due yet

Accorded the benefit of: 89

The claim(s) of this party which correspond(s) to this count is(are):
PATENTABLE CLAIMS 89 UNPATENTABLE CLAIMS

The claim(s) of this party which does(do) not correspond to this count is(are):
PATENTABLE CLAIMS 55, 59, 62-65, 88 & 90 UNPATENTABLE CLAIMS

PARTY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY

If application has been patented, have maintenance fees been paid? Yes No Maintenance fees not due yet

Accorded the benefit of:

The claim(s) of this party which correspond(s) to this count is(are):
PATENTABLE CLAIMS UNPATENTABLE CLAIMS

The claim(s) of this party which does(do) not correspond to this count is(are):
PATENTABLE CLAIMS UNPATENTABLE CLAIMS

Instructions

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- For each additional count, if any, repeat steps 2-6 and, additionally, provide an explanation why each count represents a separate patentable invention from every other count (37 CFR 1.609(b)(1)).

DATE <u>12/12/97</u>	PRIMARY EXAMINER SIGNATURE <u>Michael Milano</u>	TELEPHONE NO. <u>703-308-2496</u>	ART UNIT <u>3308</u>
DATE	GROUP DIRECTOR SIGNATURE (if required)		

The serial number and filing date of each application the benefit of which is intended to be accorded must be listed. It is not sufficient to merely list the earliest application if there are intervening applications necessary for continuity.

THIS PAGE CAN BE DUPLICATED IF THERE ARE MORE THAN TWO INTERFERING PARTIES.

Count 1:

An apparatus for reinforcing a bifurcated lumen comprising:

a first section, configured to be positioned within the lumen, comprising:

an upper limb, configured to fit within the lumen upstream of the bifurcation;

a first lower limb, configured to extend into a first leg of said bifurcation when said first section is positioned in the lumen, and

a second lower limb, shorter than said first lower limb, and configured so that when said first section is positioned in the lumen, said second lower limb does not extend into a second leg of said bifurcation.

This count is exactly the same as claim 1 of Martin, US Patent 5,575,817, and claim 89 of Cragg, Appl. 08/461,402.

The important feature of this count is that the bifurcated prosthesis has two limbs but only one limb extends across the bifurcation and into the lumen of the vessel.

Count 2:

An apparatus for reinforcing a bifurcated lumen comprising:

a first section, configured to be positioned within the lumen, comprising:

an upper limb, configured to fit within the lumen upstream of the bifurcation;

a first lower limb, configured to extend into a first leg of said bifurcation when said first section is positioned in the lumen, and

a second lower limb, shorter than said first lower limb, and configured so that when said first section is positioned in the lumen, said second lower limb does not extend into a second leg of said bifurcation, and further comprising

a second section configured to be positioned separately within the lumen and joined to said second lower limb of the first section, effectively extending said second lower limb into said second leg of said bifurcation.

This count is exactly the same as claim 2 of Martin, US Patent 5,575,817, and claim 90 of Cragg, Appl. 08/461,402.

Distinction between Counts 1 and 2.

The important feature of count 1 is that the bifurcated prosthesis has two limbs but only one limb extends across the bifurcation and into the lumen of the vessel. Count 2 requires an additional stent to be added to the short limb, thus making a two piece graft that extends into both branches of the vessel. The count 2 is patentably distinct from count 1 for this reason.

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A) Why claims correspond to Count 1.

1) Martin, US Patent 5,575,817: Claim 1 of the patent is identical to the count.

2) Cragg, application 08/461,402: Claim 89 of Cragg '402 is identical to the count.

3) Cragg, application 08/463,987: Claims 54, 59*, 63,64 and 67 of Cragg '987

correspond to the count.

Independent claim 54 defines a method for delivering a bifurcated prosthesis. The prosthesis which is implanted into the vessel is bifurcated, thus having two limbs or distal stent portions, but only one limb extends across the bifurcation and into the branch lumen of the vessel. The implanted prosthesis is the main feature of the claim. The remaining method steps of claim 54 are well know in the art. The claim would be rejected if the count was available as prior art.

Independent claim 59* defines a bifurcated prosthesis with first and second distal stent portions (analogous to the "two limbs" of the count) but only one distal stent portion extends across the bifurcation and into the branched lumen of the vessel. Claim 59* further recites a graft layer on the bifurcated stent. Such a graft layer is well know in the art and the claim would be rejected if the count was available as prior art.

Independent claim 63 recite a method for delivering a bifurcated prosthesis. The resultant prosthesis which is implanted into the vessel is bifurcated, thus having two limbs or distal stent portions, but only one limb extends across the bifurcation and into the branch lumen of the vessel. The implanted prosthesis is the main feature of the claim. Claim 63 differs slightly from the count in that the prosthesis of claim 63 is formed from two distinct pieces. When assembled according

*as filed in the After Final Amendment of 9/2/97 and stated as allowable over the cited prior art if filed in a separate amendment

to the method, the resultant prosthesis meets the limitations of the count. The claim would be rejected as obvious if the count was available as prior art.

Independent claims 65 and 67 recite a bifurcated prosthesis. The assembled prosthesis is bifurcated, thus having two limbs or distal stent portions, but only one limb extends across the bifurcation and into the branch lumen of the vessel. The implanted prosthesis is the main feature of the claim. The claims differs slightly from the count in that the prosthesis of the claims is formed from two distinct pieces. When assembled according to the claims, the resultant prosthesis meets the limitations of the count. The claim would be rejected as obvious if the count was available as prior art.

Dependent claim 64 does not recite a patentable distinct feature or method and the claim would be rejected if the count was available as prior art

B) Why claims do not correspond to Count 1.

1) Martin, US Patent 5,575,817: Claims 2-17 of the patent do not correspond to the count. Claim 2 recites a separate patentable invention in that a second section is added to the shorter lower limb to extend the shorter second lower limb into the branched lumen of the vessel.

2) Cragg, application 08/461,402: Claims 55, 59, 62-65, 88 and 90 of Cragg '402 do not correspond to the count. The claims recite a separate patentable invention in that a second section is added to the shorter distal portion (analogous to the lower limb of the count) to extend the shorter second distal portion into the branched lumen of the vessel.

3) Cragg, application 08/463,987: Claims 62, 66 and 68 of Cragg '987 do not correspond to the count. The claims recite that a second section is added to the shorter distal portion

(analogous to the lower limb of the count) to extend the shorter second distal portion into the branched lumen of the vessel.

C) Why claims correspond to Count 2.

1) Martin, US Patent 5,575,817: Claim 2 of the patent is identical to the count. Claims 3-17 do not recite patentable, distinct features and the claims would be rejected if the count was available as prior art.

2) Cragg, application 08/312,881: Claims 1-9, 11, 12, 63, 64, 66, 68-71, 73-84 correspond to the count.

Independent claims 1, 11, 63, 66 and 80 correspond to the count since a second section is added to the shorter distal portion (analogous to the second lower limb of the count) to extend the shorter second distal portion into the branched lumen of the vessel.

Claims 2-9, 12, 64, 68-71, 73-79 and 81-84 do not recite patentable, distinct features and the claims would be rejected if the count was available as prior art.

3) Cragg, application 08/461,402: Claims 55, 59, 62-65, 88 and 90 of Cragg '402 correspond to the count.

Claim 90 is identical to the count.

Independent claim 55 defines a method for delivering a bifurcated prosthesis. The prosthesis which is implanted into the vessel is bifurcated, thus having two limbs or distal stent portions, with one limb extending across the bifurcation and into the branch lumen of the vessel and a second section added to the shorter distal portion (analogous to the second lower limb of the count) to extend the shorter second distal portion into the branched lumen of the vessel. The implanted prosthesis is the main feature of the claim. The remaining method steps of claim 55 are well known in the art and would be rejected as obvious if the count was available as prior art.

Independent claim 59 recites a bifurcated prosthesis with a second section added to the

shorter distal portion (analogous to the second lower limb of the count) to extend the shorter second distal portion into the branched lumen of the vessel. This structure is identical, although worded differently, to the count.

Claims 62-65 and 88 do not recite patentable, distinct features and the claims would be rejected if the count was available as prior art.

4) Cragg, application 08/463,987: Claims 62, [REDACTED] and 68 of Cragg '987 correspond to count 2.

Claims 62, [REDACTED] and 68 recite a bifurcated prosthesis with a second section added to the shorter distal portion (analogous to the second lower limb of the count) to extend the shorter second distal portion into the branched lumen of the vessel. This structure is identical, although worded differently, to the count. Claim 68 further recites a graft layer on the bifurcated stent. Such a graft layer is well known in the art and the claim would be rejected as obvious if the count was available as prior art.

5) Fogarty, application 08/463,836: Claims 27-69 correspond to count 2.

Independent claim 27 recites a method for forming a bifurcated structure with a first section (graft) added to one leg/connector section of the bifurcated structure forming a bifurcated prosthesis having two limbs but only one limb extends across the bifurcation and into the lumen of the vessel. The second section is then added to the shorter lower limb of the resultant bifurcated prosthesis to extend the shorter limb into the branched lumen of the vessel. The structure is the patentable feature of the method claim. This resultant structure is identical, although worded differently, to the count.

Independent claim 41 recites a method for introducing a bifurcated graft with a second

section added to the shorter second lower limb to extend the shorter second lower limb into the branched lumen of the vessel. The structure is the patentable feature of the method claim. This structure is identical, although worded differently, to the count.

Claims 28-40 and 42-69 do not recite patentable, distinct features and the claims would be rejected if the count was available as prior art.

D) Why claims do not correspond to Count 2.

1) Martin, US Patent 5,575,817: Claim 1 of the patent does not correspond to count 2.

The important feature of claim 1 is that the bifurcated prosthesis has two limbs but only one limb extends across the bifurcation and into the lumen of the vessel. Count 2 requires an additional stent to be added to the short limb, thus making a two piece graft that extends into both branches of the vessel. The count 2 is patentably distinct from Martin's claim 1 for this reason.

2) Cragg, application 08/312,881: Claims 13-17 and 38 do not correspond to the count.

Claims 13-17 and 38 merely recite a bifurcated stent with a graft layer. The first and second distal stent portions are integral with the proximal stent portion and will simultaneously extend into the branches of the vessel when the proximal portion is deployed. Count 2 requires an additional stent to be added to the short limb, thus making a two piece prosthesis that extends into both branches of the vessel.

3) Cragg, application 08/461,402: Claim 89 of Cragg '402 does not correspond to the count.


The important feature of claim 89 is that the bifurcated prosthesis has two limbs but only one limb extends across the bifurcation and into the lumen of the vessel. Count 2 requires an additional stent to be added to the short limb, thus making a two piece graft that extends into both

branches of the vessel. The count 2 is patentably distinct from the Cragg '402 claim 89 for this reason.

4) Cragg, application 08/463,987: Claims 54, 59, 63, 64 and 67 of Cragg '987 do not correspond to the count.

The important feature of claims is that the bifurcated prosthesis has two limbs but only one limb extends across the bifurcation and into the lumen of the vessel. Count 2 requires an additional stent to be added to the short limb, thus making a two piece graft that extends into both branches of the vessel. The count 2 is patentably distinct from the Cragg '987 claims for this reason.

5) Fogarty, application 08/463,836: All claims correspond to count 2.


MICHAEL J. MILANO
PRIMARY EXAMINER
GROUP 300

INTERFERENCE INITIAL MEMORANDUM

BOARD OF PATENT APPEALS AND INTERFERENCES: An interference is found to exist between the following cases:

This interference involves 5 partiesCount # 2104084(B)

PARTY <u>MARTIN</u>	SERIAL NO. <u>08/293,541</u>	FILING DATE <u>8/19/94</u>	PATENT NO., IF ANY <u>5,575,811</u>	ISSUE DATE, IF ANY <u>11/19/96</u>
If application has been patented, have maintenance fees been paid? <u>Yes</u> <u>No</u> <u>X</u> Maintenance fees not due yet				
Accorded the benefit of:	SERIAL NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
COUNTRY				
The claim(s) of this party which correspond(s) to this count is(are):				
PATENTABLE CLAIMS <u>2-17</u>				
UNPATENTABLE CLAIMS				
The claim(s) of this party which does(do) not correspond to this count is(are):				
PATENTABLE CLAIMS				
UNPATENTABLE CLAIMS				
PARTY <u>CRAIG</u>	SERIAL NO. <u>08/413,787</u>	FILING DATE <u>06/05/95</u>	PATENT NO., IF ANY	ISSUE DATE, IF ANY
If application has been patented, have maintenance fees been paid? <u>Yes</u> <u>No</u> <u>X</u> Maintenance fees not due yet				
Accorded the benefit of:	SERIAL NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
COUNTRY				
<u>EPO</u>	<u>EP94400284.9</u>	<u>2/09/94</u>		
<u>EPO</u>	<u>EP94401306.9</u>	<u>6/10/94</u>		
<u>US</u>	<u>08/312,881</u>	<u>9/27/94</u>		
<u>US</u>	<u>08/317,763</u>	<u>10/04/94</u>	<u>5,609,627</u>	<u>03/11/97</u>
The claim(s) of this party which correspond(s) to this count is(are):				
PATENTABLE CLAIMS <u>62, 68</u>				
UNPATENTABLE CLAIMS				
The claim(s) of this party which does(do) not correspond to this count is(are):				
PATENTABLE CLAIMS <u>54, 59, 63, 64, 67</u>				
UNPATENTABLE CLAIMS				

Instructions

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 - For each claim designated as corresponding to the count, provide an explanation of why each claim defines the same patentable invention (37 CFR 1.609(b)(2)).
 - For each claim designated as not corresponding to the count, provide an explanation of why each claim defines a separate patentable invention (37 CFR 1.609(b)(3)).
 - For each additional count, if any, repeat steps 2-6 and, additionally, provide an explanation why each count represents a separate patentable invention from every other count (37 CFR 1.609(b)(1)).

DATE <u>12/12/97</u>	PRIMARY EXAMINER (signature) <u>Michael Milano</u>	TELEPHONE NO. <u>703-308-2496</u>	ART UNIT <u>3308</u>
DATE	GROUP DIRECTOR SIGNATURE (if required)		

The serial number and filing date of each application the benefit of which is intended to be accorded must be listed. It is not sufficient to merely list the earliest application if there are intervening applications necessary for continuity.

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INTERFERENCE INITIAL MEMORANDUM

Count # 2BOARD OF PATENT APPEALS AND INTERFERENCES: An interference is found to exist between the following cases:
This interference involves 5 parties

PARTY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
CRAGG	08/1901, 752	06/06/93		
If application has been patented, have maintenance fees been paid? <u>Yes</u> <u>No</u> Maintenance fees not due yet				
*Accorded the benefit of COUNTRY				
EPO	EP94400284.9	2/09/94		
EPO	EP94401306.9	6/10/94		
US	08/317,763	10/04/94		
The claim(s) of this party which correspond(s) to this count is(are): PATENTABLE CLAIMS <u>55, 59, 62-65, 88, 90</u> UNPATENTABLE CLAIMS				
The claim(s) of this party which does(not) correspond to this count is(are): PATENTABLE CLAIMS <u>89</u> UNPATENTABLE CLAIMS				

PARTY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
CRAGG	08/312,881	9/27/94		
If application has been patented, have maintenance fees been paid? <u>Yes</u> <u>No</u> Maintenance fees not due yet				
*Accorded the benefit of COUNTRY				
EPO	EP94400284.9	02/09/94		
EPO	EP94401306.9	6/10/94		
The claim(s) of this party which correspond(s) to this count is(are): PATENTABLE CLAIMS <u>1-9, 11, 12, 63, 64, 66, 68-71, 73-79, 80-84</u> UNPATENTABLE CLAIMS				
The claim(s) of this party which does(not) correspond to this count is(are): PATENTABLE CLAIMS <u>13-17, 38</u> UNPATENTABLE CLAIMS				

Instructions

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 - For each claim designated as corresponding to the count, provide an explanation of why each claim defines the same patentable invention (37 CFR 1.609(b)(2)).
 - For each claim designated as not corresponding to the count, provide an explanation of why each claim defines a separate patentable invention (37 CFR 1.609(b)(3)).
 - For each additional count, if any, repeat steps 2-6 and, additionally, provide an explanation why each count represents a separate patentable invention from every other count (37 CFR 1.609(b)(1)).

DATE	12/12/97	PRIMARY EXAMINER (Signature)	Michael J. Mulvaney	TELEPHONE NO.	703-308-2476	PART UNIT	3308
DATE		GROUP DIRECTOR SIGNATURE (if required)					

*The serial number and filing date of each application the benefit of which is intended to be accorded must be listed. It is not sufficient to merely list the earliest application if there are intervening applications necessary for continuity.

THIS PAGE CAN BE DUPLICATED IF THERE ARE MORE THAN TWO INTERFERING PARTIES.

INTERFERENCE INITIAL MEMORANDUM

Count # 2

BOARD OF PATENT APPEALS AND INTERFERENCES: An interference is found to exist between the following cases:
This interference involves 5 parties

PARTY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
FOOARTS	08/163,886	06/05/95		
If application has been patented, have maintenance fees been paid? <u>Yes</u> <u>No</u> Maintenance fees not due yet				
*Accorded the benefit of:				
COUNTRY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
US	08/255,681	6/8/94		
The claim(s) of this party which correspond(s) to this count is(are):				
PATENTABLE CLAIMS		UNPATENTABLE CLAIMS		
27-69				
The claim(s) of this party which does(do) not correspond to this count is(are):				
PATENTABLE CLAIMS		UNPATENTABLE CLAIMS		
27-69				

PARTY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
If application has been patented, have maintenance fees been paid? <u>Yes</u> <u>No</u> Maintenance fees not due yet				
*Accorded the benefit of:				
COUNTRY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
The claim(s) of this party which correspond(s) to this count is(are):				
PATENTABLE CLAIMS		UNPATENTABLE CLAIMS		
The claim(s) of this party which does(do) not correspond to this count is(are):				
PATENTABLE CLAIMS		UNPATENTABLE CLAIMS		

Instructions

- For every patent involved in the interference, check if the fees have been paid by contacting the MAINTENANCE FEE DEPARTMENT at 308-5069. If fees are due and they have not been paid, the interference cannot be declared since it would involve an expired patent (35 USC 135(a); 37 CFR 1.606).
 - For each party, separately identify the patentable and unpatentable claims which correspond to the count (37 CFR 1.601 (f), 1.601 (n), 1.609(b)(2)).
 - For each party, separately identify the patentable and unpatentable claims which do not correspond to the count (37 CFR 1.609(b)(3)).
 - Forward all files including those the benefit of which is being accorded.
 - Keep a copy of the Interference Initial Memorandum and any attachments for your records.
- All information requested below must be attached on (a) separate sheet(s) and type-written.
- On a separate sheet, set forth a single proposed interference count. If any claim of any party is exactly the same word for word as this count, please indicate the party, application or patent number, and the claim number.
 - For each claim designated as corresponding to the count, provide an explanation of why each claim defines the same patentable invention (37 CFR 1.609(b)(2)).
 - For each claim designated as not corresponding to the count, provide an explanation of why each claim defines a separate patentable invention (37 CFR 1.609(b)(3)).
 - For each additional count, if any, repeat steps 2-6 and, additionally, provide an explanation why each count represents a separate patentable invention from every other count (37 CFR 1.609(b)(1)).

DATE	PRIMARY EXAMINER (Signature)	TELEPHONE NO.	ART UNIT
12/12/97	Michael J. Milano	703-308-2496	3308
DATE	GROUP DIRECTOR SIGNATURE (if required)		

The serial number and filing date of each application the benefit of which is intended to be accorded must be listed. It is not sufficient to merely list the earliest application if there are intervening applications necessary for continuity.

THIS PAGE CAN BE DUPLICATED IF THERE ARE MORE THAN TWO INTERFERING PARTIES.

Count 1:

An apparatus for reinforcing a bifurcated lumen comprising:

a first section, configured to be positioned within the lumen, comprising:

an upper limb, configured to fit within the lumen upstream of the bifurcation;

a first lower limb, configured to extend into a first leg of said bifurcation when said first section is positioned in the lumen, and

a second lower limb, shorter than said first lower limb, and configured so that when said first section is positioned in the lumen, said second lower limb does not extend into a second leg of said bifurcation.

This count is exactly the same as claim 1 of Martin, US Patent 5,575,817, and claim 89 of Cragg, Appl. 08/461,402.

The important feature of this count is that the bifurcated prosthesis has two limbs but only one limb extends across the bifurcation and into the lumen of the vessel.

Count 2:

An apparatus for reinforcing a bifurcated lumen comprising:

a first section, configured to be positioned within the lumen, comprising:

an upper limb, configured to fit within the lumen upstream of the bifurcation;

a first lower limb, configured to extend into a first leg of said bifurcation when said first section is positioned in the lumen, and

a second lower limb, shorter than said first lower limb, and configured so that when said first section is positioned in the lumen, said second lower limb does not extend into a second leg of said bifurcation, and further comprising

a second section configured to be positioned separately within the lumen and joined to said second lower limb of the first section, effectively extending said second lower limb into said second leg of said bifurcation.

This count is exactly the same as claim 2 of Martin, US Patent 5,575,817, and claim 90 of Cragg, Appl. 08/461,402.

Distinction between Counts 1 and 2.

The important feature of count 1 is that the bifurcated prosthesis has two limbs but only one limb extends across the bifurcation and into the lumen of the vessel. Count 2 requires an additional stent to be added to the short limb, thus making a two piece graft that extends into both branches of the vessel. The count 2 is patentably distinct from count 1 for this reason.

A) Why claims correspond to Count 1.

1) Martin, US Patent 5,575,817: Claim 1 of the patent is identical to the count.

2) Cragg, application 08/461,402: Claim 89 of Cragg '402 is identical to the count.

3) Cragg, application 08/463,987: Claims 54, 59*, 63,64 and 67 of Cragg '987

correspond to the count.

Independent claim 54 defines a method for delivering a bifurcated prosthesis. The prosthesis which is implanted into the vessel is bifurcated, thus having two limbs or distal stent portions, but only one limb extends across the bifurcation and into the branch lumen of the vessel. The implanted prosthesis is the main feature of the claim. The remaining method steps of claim 54 are well known in the art. The claim would be rejected if the count was available as prior art.

Independent claim 59* defines a bifurcated prosthesis with first and second distal stent portions (analogous to the "two limbs" of the count) but only one distal stent portion extends across the bifurcation and into the branched lumen of the vessel. Claim 59* further recites a graft layer on the bifurcated stent. Such a graft layer is well known in the art and the claim would be rejected if the count was available as prior art.

Independent claim 63 recites a method for delivering a bifurcated prosthesis. The resultant prosthesis which is implanted into the vessel is bifurcated, thus having two limbs or distal stent portions, but only one limb extends across the bifurcation and into the branch lumen of the vessel. The implanted prosthesis is the main feature of the claim. Claim 63 differs slightly from the count in that the prosthesis of claim 63 is formed from two distinct pieces. When assembled according

*as filed in the After Final Amendment of 9/2/97 and stated as allowable over the cited prior art if filed in a separate amendment

to the method, the resultant prosthesis meets the limitations of the count. The claim would be rejected as obvious if the count was available as prior art.

Independent claims 65 and 67 recite a bifurcated prosthesis. The assembled prosthesis is bifurcated, thus having two limbs or distal stent portions, but only one limb extends across the bifurcation and into the branch lumen of the vessel. The implanted prosthesis is the main feature of the claim. The claims differs slightly from the count in that the prosthesis of the claims is formed from two distinct pieces. When assembled according to the claims, the resultant prosthesis meets the limitations of the count. The claim would be rejected as obvious if the count was available as prior art.

Dependent claim 64 does not recite a patentable distinct feature or method and the claim would be rejected if the count was available as prior art

B) Why claims do not correspond to Count 1.

1) Martin, US Patent 5,575,817: Claims 2-17 of the patent do not correspond to the count. Claim 2 recites a separate patentable invention in that a second section is added to the shorter lower limb to extend the shorter second lower limb into the branched lumen of the vessel.

2) Cragg, application 08/461,402: Claims 55, 59, 62-65, 88 and 90 of Cragg '402 do not correspond to the count. The claims recite a separate patentable invention in that a second section is added to the shorter distal portion (analogous to the lower limb of the count) to extend the shorter second distal portion into the branched lumen of the vessel.

3) Cragg, application 08/463,987: Claims 62, 66 and 68 of Cragg '987 do not correspond to the count. The claims recite that a second section is added to the shorter distal portion

(analogous to the lower limb of the count) to extend the shorter second distal portion into the branched lumen of the vessel.

C) Why claims correspond to Count 2.

1) Martin, US Patent 5,575,817: Claim 2 of the patent is identical to the count. Claims 3-17 do not recite patentable, distinct features and the claims would be rejected if the count was available as prior art.

2) Cragg, application 08/312,881: Claims 1-9, 11, 12, 63, 64, 66, 68-71, 73-84 correspond to the count.

Independent claims 1, 11, 63, 66 and 80 correspond to the count since a second section is added to the shorter distal portion (analogous to the second lower limb of the count) to extend the shorter second distal portion into the branched lumen of the vessel.

Claims 2-9, 12, 64, 68-71, 73-79 and 81-84 do not recite patentable, distinct features and the claims would be rejected if the count was available as prior art.

3) Cragg, application 08/461,402: Claims 55, 59, 62-65, 88 and 90 of Cragg '402 correspond to the count.

Claim 90 is identical to the count.

Independent claim 55 defines a method for delivering a bifurcated prosthesis. The prosthesis which is implanted into the vessel is bifurcated, thus having two limbs or distal stent portions, with one limb extending across the bifurcation and into the branch lumen of the vessel and a second section added to the shorter distal portion (analogous to the second lower limb of the count) to extend the shorter second distal portion into the branched lumen of the vessel. The implanted prosthesis is the main feature of the claim. The remaining method steps of claim 55 are well known in the art and would be rejected as obvious if the count was available as prior art.

Independent claim 59 recites a bifurcated prosthesis with a second section added to the

shorter distal portion (analogous to the second lower limb of the count) to extend the shorter second distal portion into the branched lumen of the vessel. This structure is identical, although worded differently, to the count.

Claims 62-65 and 88 do not recite patentable, distinct features and the claims would be rejected if the count was available as prior art.

4) Cragg, application 08/463,987: Claims 62, [REDACTED] and 68 of Cragg '987 correspond to count 2.

Claims 62, [REDACTED] and 68 recite a bifurcated prosthesis with a second section added to the shorter distal portion (analogous to the second lower limb of the count) to extend the shorter second distal portion into the branched lumen of the vessel. This structure is identical, although worded differently, to the count. Claim 68 further recites a graft layer on the bifurcated stent. Such a graft layer is well known in the art and the claim would be rejected as obvious if the count was available as prior art.

5) Fogarty, application 08/463,836: Claims 27-69 correspond to count 2.

Independent claim 27 recites a method for forming a bifurcated structure with a first section (graft) added to one leg/connector section of the bifurcated structure forming a bifurcated prosthesis having two limbs but only one limb extends across the bifurcation and into the lumen of the vessel. The second section is then added to the shorter lower limb of the resultant bifurcated prosthesis to extend the shorter limb into the branched lumen of the vessel. The structure is the patentable feature of the method claim. This resultant structure is identical, although worded differently, to the count.

Independent claim 41 recites a method for introducing a bifurcated graft with a second

section added to the shorter second lower limb to extend the shorter second lower limb into the branched lumen of the vessel. The structure is the patentable feature of the method claim. This structure is identical, although worded differently, to the count.

Claims 28-40 and 42-69 do not recite patentable, distinct features and the claims would be rejected if the count was available as prior art.

D) Why claims do not correspond to Count 2.

1) Martin, US Patent 5,575,817: Claim 1 of the patent does not correspond to count 2.

The important feature of claim 1 is that the bifurcated prosthesis has two limbs but only one limb extends across the bifurcation and into the lumen of the vessel. Count 2 requires an additional stent to be added to the short limb, thus making a two piece graft that extends into both branches of the vessel. The count 2 is patentably distinct from Martin's claim 1 for this reason.

2) Cragg, application 08/312,881: Claims 13-17 and 38 do not correspond to the count.

Claims 13-17 and 38 merely recite a bifurcated stent with a graft layer. The first and second distal stent portions are integral with the proximal stent portion and will simultaneously extend into the branches of the vessel when the proximal portion is deployed. Count 2 requires an additional stent to be added to the short limb, thus making a two piece prosthesis that extends into both branches of the vessel.

3) Cragg, application 08/461,402: Claim 89 of Cragg '402 does not correspond to the count.

The important feature of claim 89 is that the bifurcated prosthesis has two limbs but only one limb extends across the bifurcation and into the lumen of the vessel. Count 2 requires an additional stent to be added to the short limb, thus making a two piece graft that extends into both

branches of the vessel. The count 2 is patentably distinct from the Cragg '402 claim 89 for this reason.

4) Cragg, application 08/463,987: Claims 54, 59, 63, 64 and 67 of Cragg '987 do not correspond to the count.

The important feature of claims is that the bifurcated prosthesis has two limbs but only one limb extends across the bifurcation and into the lumen of the vessel. Count 2 requires an additional stent to be added to the short limb, thus making a two piece graft that extends into both branches of the vessel. The count 2 is patentably distinct from the Cragg '987 claims for this reason.

5) Fogarty, application 08/463,836: All claims correspond to count 2.


MICHAEL J. MILANO
PRIMARY EXAMINER
GROUP 300

INTERFERENCE DIGEST

Interference No. 104,083 Paper No. 15
Name, George Goicoechea et al.
Serial No. 08/461,402 Patent No. _____
Title, BIFURCATED ENDOLUMINAL PROSTHESIS
Filed, 06/05/95
Interference with Martin

DECISION ON MOTIONS

Examiner-in-Chief, _____ Dated, _____

FINAL DECISION

Board of Patent Appeals and Interferences, FAVORABLE Dated, 3/10/99

Court, _____ Dated, _____

REMARKS

